Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte JAMES C. CHEN and LIN SUNG HUI
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Appeal No. 1998-1601
Application No. 08/679,595
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ON BRIEF
_____

Before KRASS, BARRETT and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 7, all of the claims in the application.

The invention is directed to a method for scanning small documents, e.g., business cards, by using a card reading kit. The card reading kit comprises a plastic board with a plurality of blocks into which the small documents are inserted. All of the small documents are scanned together and a master image file is generated and then processed by using a

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form file, comprising a location for each of the blocks on the card reader kit, to generate a

document image file for each of the small documents.

Independent claim 1 is reproduced as follows:

1. In a data processing system, a method for scanning a plurality of small
documents by using a card reader kit which comprises a plurality of blocks
for placing the small documents, said system comprising a form file which
comprises a location for each of the blocks on the card reader kit, said
method comprising:

(1) placing each of the small documents on one block of the card
reader kit;

(2) scanning the card reader kit coupled with the small documents
into the system to generate a master image file;

(3) processing the master image file by using the form file to
generate a document image file for each of the small documents.

The examiner relies on the following references:

Konishi et al. (Konishi)	5,237,156	Aug. 17, 1993
Nasset	5,331,380	Jul. 19, 1994
Bodapati et al. (Bodapati)	5,483,325	Jan. 09, 1996

Claims 1 through 7 stand rejected under 35 U.S.C. § 103. As evidence of

obviousness, the examiner cites Bodapati and Konishi with regard to claims 1 through 5,

adding Nasset with regard to claims 6 and 7.

Reference is made to the brief and answer for the respective positions of

appellants and the examiner.

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OPINION

We reverse.

With regard to independent claim 1, the examiner applies Bodapati for the teaching of scanning a plurality of small documents by placing the documents in a frame. The examiner recognized that Bodapati was deficient in a teaching of the generation of a master image file and the processing of such a file, as claimed. Therefore, the examiner relied on Konishi for the teaching of the claimed processing and found that it would have been obvious to combine the references by connecting the flow of data methodology of Konishi with the Bodapati apparatus.

We agree that Bodapati clearly teaches a card reader kit containing blocks for placement of small documents therein, as claimed. We also agree that Bodapati is deficient in teaching anything about generating a master image file and processing that master image file, as claimed. Bodapati also fails to teach the "form file" which comprises a location for each of the blocks on the card reader kit. If Konishi supplied these deficiencies, then we might agree with the examiner that it would have been obvious to combine these references and that the combination would have been suggestive of the instant claimed subject matter. The problem is that Konishi is no more applicable to a teaching of generating document image files "for each of the small documents" than is Bodapati.

In Konishi, it appears that while the reference teaches using index information and generating an index file showing the relationship between detected index information and a storage address of the image information, we find nothing in Konishi, and the examiner has pointed to nothing therein, which suggests that the documents are automatically processed in a manner so as to provide document image files "for each" of a plurality of images on the document. We find nothing in Konishi that would indicate that anything more than a complete document is indexed and scanned and then stored on microfilm, for example.
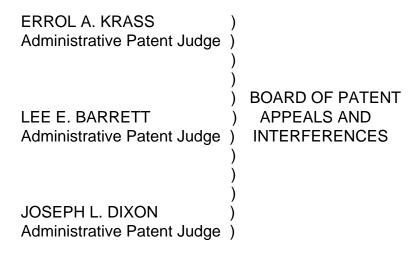
Instant claim 1, on the other hand, requires a "form file" which comprises a location for each of the blocks on the card reader kit. We find nothing in either Bodapati or Konishi corresponding to the claimed "form file." Moreover, claim 1 also requires that a master image file be generated and then the master image file is processed "by using the form file to generate a document image file for each of the small documents." Thus, it is clear that the instant claimed subject matter permits accessing *portions* of a scanned document, by creating a document image file for each of a plurality of smaller documents existing on the original scanned "document." We find no such teaching or suggestion in either Bodapati or Konishi or the combination thereof.

Accordingly, we will not sustain the rejection of independent claim 1 under

35 U.S.C. § 103, or of claims 2 through 5, dependent thereon.

The rejection of claims 6 and 7 under 35 U.S.C. § 103 relies on Nasset, in addition

to Bodapati and Konishi. While Nasset does appear to provide for a plurality of

transparent pockets for holding the small documents, Nasset does nothing to provide for

the deficiencies of Bodapati and Konishi noted <u>supra</u>. Accordingly, we also will not

sustain the rejection of claims 6 and 7 under 35 U.S.C. § 103.

The examiner's decision rejecting claims 1 through 7 under 35 U.S.C. § 103 is

reversed.

<u>REVERSED</u>

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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Winston Hsu
3F No. 52 Lane 46
Min-Sheng Rd.
Yungho City, Taipei Hsien
Taiwan, R.O.C.